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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/417,399 10/13/99 HUBERMAN

S MBI-1036

EXAMINER

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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13

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Examiner's Answer Attached

Sam Rimell
Primary Examiner
Art Unit: 2166



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/417,399
Filing Date: October 13, 1999
Appellant(s): HUBERMAN ET AL.

MAILED

OCT 10 2001

Technology Center 2100

John L. Knoble
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed June 25, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief are substantially correct.

In light of appellant's arguments in the brief, claims 6 and 26-36 are indicated as containing allowable subject matter. However, these claims remain rejected under 35 USC 112.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

U.S. Patent 5,217,256 issued to Lomas, published June 8, 1993.

U.S. Patent 5,626,366 issued to Lee, published May 6, 1997.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-14, 16-18, 20-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The reasons for these rejections were set forth in the office action of September 26, 2000, and are hereby incorporated by reference.

Claims 1-5, 7-8, 12-14, 16-18 and 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lomas.

The reasons for this rejection were set forth in the office action of September 26, 2000, and are hereby incorporated by reference.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lomas.

The reasons for this rejection were set forth in the office action of September 26, 2000, and are hereby incorporated by reference.

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee.

The reasons for this rejection were set forth in the office action of September 26, 2000, and are hereby incorporated by reference.

Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 26-36 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

(11) *Response to Argument*

Rejection of claims 1 and 26 under 35 USC 112: The phrase “sized and dimensioned to be comfortably fit into an infant’s mouth” has been found to be indefinite. There are essentially three problems that arise when deploying this type of claim language:

(1) The first problem arises in trying to define the size of infant’s mouth. Since the claimed infant is a human being, the size will change depending upon the infant’s age. There are also individual variations among different children that further complicate this analysis. While government authorities, such as the Consumer Product Safety Commission have established minimum size guidelines for toys to prevent choking, these guidelines only establish the minimum baseline for size, and do not dictate the entire range of usable sizes in manufactured articles. Further complicating the issue is the fact that some safety guidelines are based on age, and vary depending upon the age of the user. This is often why toys are labelled with tags identifying the preferred age of the child, since it is understood that the safety of the toy is based upon the size of the child as dictated by child’s age. Given these variables it not seen how it is possible to meet the requirements of 35 USC 112 necessary to define the size and dimensions of the claimed article.

(2) The second problem is that the ability to teethe (i.e. bite) a structure is not the same as the ability to comfortably fit the structure in an infant’s mouth, and the claims recite both. Practically any structure can be teethed. It is well known for children to teethe on car seats and furniture when they are young, yet it is not reasonable to assume that a car seat or furniture piece could fit comfortably inside one’s mouth.

(3) The third problem is the basic issue of defining size of physical structures by comparing them to human anatomy. The case law to *In re Wiggins* and *Orthokinetics Inc v. Safety Travel Chairs Inc.* (cited by appellant, page 7 of brief) are not on point in dealing with this issue, and do not address the concept of comparing a physical structure to the human anatomy. Examiner maintains that the attempt to define the size of a physical structure by comparing it to the human anatomy violates the primary purpose of the requirement for definiteness in the claims. MPEP 2173 states:

"The primary purpose of this requirement for definiteness of claim language is to ensure that the scope of the claims is clear, so the public is informed of the boundaries of what constitutes infringement of the patent".

When appellant is attempting to define the size of a structure by comparing it to undefined and highly variable dimensions of the human anatomy, it becomes impossible to determine the scope of the claims, and the public interest of knowing the clear boundaries of a claim cannot be served.

Rejection of claim 3 under 35 USC 112: The phrase "integrated into said artwork is found to be vague and indefinite. The question here is really a question of what is meant by the term "integrated". Does it mean that the teething element is attached to the artwork? Does it mean that the teething element has a similar design to the artwork? Does it mean that the teething element completes a missing component of the artwork? The term "integrated" is ambiguous in the context of the claims that its precise meaning cannot be determined.

Rejection of claim 13 under 35 USC 112: This rejection has been withdrawn in light of appellant's stated reasons. Claim 13 is only rejected due to its indirect dependence on claim 1.

Art Unit: 2166

Rejection of claims 14 and 18: The phrases “gripping means comprising teething means” and “leaf weight means comprising teething means” are each found to be indefinite. The problem that arises is that appellant is using different terms to define the exact same structure. As a result, it is not clear which term actually limits the claim. For example, if appellant defines the same structure as both a “teething means” and a “gripping means” it is not clear which term actually limits the claims, and which functions must be met to anticipate the recited structure. While appellant argues that there is no specific legal prohibition against using two different terms to define the same structure, it is maintained that 35 USC 112 is a direct prohibition against such practice. MPEP 2172 states that the primary purpose of the definiteness requirement of 35 USC 112 is to ensure that the scope of the claims is clear so that the public may be informed of the boundaries of what constitutes infringement of the patent. When appellant relies on different terms to define the very same structure, the scope of claims cannot be determined since it is not clear which terms will actually limit the claim scope. Analogous case law resides in *Ex Parte Wu*, 10 USPQ 2d 2031, 2033 (Bd. Pat. App. & Inter. 1989) where language specifying two different ranges of limitation within the same claim were found to be indefinite, since the metes and bounds of the claim could not be determined from the conflicting ranges.

Rejection of claims 1-5, 7-8, 12-14, 16-18 and 20-25 under 35 USC 102(b) as being anticipated by Lomas:

Appellant's position on these claims is clearly stated on pages 14-15 of the brief, where appellant outlines six different arguments against the application of the Lomas reference. Many of these argument are repeated in a discussion of the dependent claims, so it will not be

necessary to repeat them over again for each dependent claim. Instead, each of these 6 points will be addressed in detail.

1. Appellant's position that Lomas fails to disclose a "teething toy" as recited in claim preambles: Examiner's position is that the structure (10) of Lomas is capable of being teathed (i.e. bitten), and thus meets the functional requirements of being a "teething element" or "teething toy" if the term "teething" could possibly be attributed patentable weight. However, it does not appear that the term "teething" should even be attributed patentable weight in the first place. MPEP 2111.02 defines an explicit prohibition to attributing patentable weight to a preamble when it merely recites an intended usage of a structure. Specifically, MPEP 2111.02 states:

"On the other hand, a preamble is generally not accorded any patentable weight where is merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness, but, instead, the process steps or structural limitations are able to stand alone."

Under these limitations, the preamble "A teething toy, comprising:" would not appear to be attributable any patentable weight.

2. Appellant's position that Lomas does not disclose a "book-like structure" having a plurality of leaves: Appellant's invention is not actually a standard book with a cover, but a series of individual leaves which are bound together. Appellant's invention is not disclosed as having a cover which is physically different from the leaves, so the term "book-like" rather than "book" is a logical and sensible description for appellant's invention. However, the device of Lomas has the very same characteristics as appellant's invention. A stack of paper serves as the

Art Unit: 2166

series of leaves which are bound together. No hardbound cover is used. These characteristics meet appellant's description of a "book-like" structure as provided in appellant's disclosure. Appellant also argues that the invention of Lomas lacks a plurality of leaves. However, this is directly contradicted by the term "Paper Stack" used in the title of the invention and throughout the disclosure of Lomas. A stack of paper is clearly a plurality of leaves.

3. Appellant's position that Lomas fails to disclose a "teething element": The element (10) of Lomas is capable of being teathed (i.e. bitten), and thus would read on the claims as a "teething element" if the term "teething" could possibly be attributed patentable weight. However, since the term "teething" only imparts an intended usage to the element, Examiner maintains that the term "teething" in "teething element" should not be attributed patentable weight.

4. Appellant's argument that the paper element (10) of Lomas is toxic: Lomas discloses that element (10) is being formed from colored paper. There is absolutely no suggestion that the materials used to form the element (10) are toxic. Such suggestions are baseless.

5. Appellant's argument that the element (10) of Lomas is not sized and dimensioned to be comfortably inserted into an infant's mouth: Examiner maintains that the element (10) of Lomas could be bitten or teathed, as could practically any physical structure, as described above in the discussion of the rejection under 35 USC 112. As to whether or not the element of Lomas has the specific size and shape requirements to meet the phrase "comfortably inserted in to an infant's mouth", this cannot be determined. The size of an infant's mouth is not defined.

6. Appellant's argument that the element (10) of Lomas has sharp edges. The element (10) of Lomas does not have any sharp edges. Appellant's argument is based on an assumption

Art Unit: 2166

that the staple is part of the element (10). However, the staple is clearly not part of the element (10) and is used as a separate binding device. The element (10) is formed from paper and has folded portions, none of which would be considered to be sharp edges.

Appellant has also presented certain additional arguments. Appellant argues that the leaves of Lomas lack any artwork. Examiner maintains that any printed matter that may exist on the leaves used in Lomas constitute "artwork". The leaves deployed in Lomas may include indicia (col. 1, lines 14-15).

Rejection of Claims 9-10 under 35 USC 103(a) as being obvious in Lomas:

Appellant argues that Lomas does not directly disclose the size dimensions represented in claims 9-10. Appellant also repeats all of the previously recited arguments against the Lomas reference as discussed above, none of which are relevant to the issues in claims 9-10. Examiner agrees that Lomas does not directly disclose the dimensions recited in claims 9-10, but the issue is whether such dimensions would have been obvious to the person of ordinary skill in the art at the time of invention. Examiner maintains that the dimensions recited in claims 9-10 would have been obvious to the person of ordinary skill in the art as a choice of design in view of Lomas. The skilled artisan would readily recognize that the element (10) of Lomas could have any set of dimensions necessary to perform its function as a paper stack protection device. The reference to Lomas does not limit the element (10) to specific ranges of size and does not attribute criticality to specific size ranges. The skilled artisan would thus recognize that the element (10) of Lomas could be formed in essentially any size needed.

Art Unit: 2166

Rejection of Claims 1 and 11 under 35 USC 102(b) as being anticipated by Lee

Appellant presents 6 arguments on pages 32-33 of the brief against the Lee reference which will be addressed individually:

1. Appellant's arguments that Lee does not meet the preamble limitation of being a teething toy:

Examiner maintains that the element (10) of Lee could be teethered, assuming that patentable weight were being attributed to the term "teething toy" in the preamble. However, it is maintained that no patentable weight is attributable to the term "teething toy" since it only imparts intended usage. See MPEP 2111.02.

2. Appellant's argument that the Lee device cannot serve as a teething toy due to hardness and the presence of sharp edges:

The device (10) of Lee does not specify the presence of hard surfaces and does not illustrate any sharp surfaces. These arguments are baseless.

3. Appellant's argument that the element (10) of Lee is toxic:

The Lee reference does not ever disclose the use of toxic ingredients in any of the elements of the disclosed invention. This argument is baseless.

4. Appellant's argument that the element (10) of Lee is not dimensioned to be comfortably inserted in to an infant's mouth:

It is maintained that the element (10) of Lee could be bitten into or teethered. As to the question of whether it could be comfortably inserted into an infant's mouth, this would be dependent on the size of the infant's mouth, which is not defined.

Art Unit: 2166

5. Appellant's argument that the element (10) of Lee has a sharp edge at its outer corner making it unsafe for teething:

The reference of Lee does not ever recite the presence of sharp edges. The usage of leather, cardboard and coated paper (col. 6, lines 8-10) to produce the element would result in embodiments of the element that could not logically have sharp edges.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




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Primary Examiner

Art Unit 2166

October 9, 2001

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